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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,880	11/13/2003	Ming Ta Hsu	24061.50 (TSMC2002-1130)	2319
42717	7590	04/07/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			LEVINE, ADAM L	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,880

Applicant(s)

HSU ET AL.

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14-20 and 22-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-20 and 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to applicants' amendments and remarks filed January 23, 2006. These amendments and remarks were filed in response to the office action mailed November 17, 2005. Claims 1-2, 4-12, 14-20, and 22-34 are pending. Claims 1,4-9, 11,14-19, 22-26, and 28-30 have been amended along with specification paragraphs 22, 36, and 45. Drawing figures 6-8 are newly filed. All pending claims are considered in this final office action.

Response to Amendment

Claim objections

Claims 9 and 26 have been amended to overcome objections. The amendments effectively correct errors in the claims and the objections are therefore withdrawn.

Rejections under 112 in the previous office action

Claim 4 was rejected in the prior action because it was missing an essential element. This rejection has been overcome by amending the substance of claim 4 to add significant functionality. The substance of claim 4 is now incorporated in claim 1.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 4-12, 14-20, and 22-34 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Pertaining to rejections under 102(b) in the previous office action

Significant substantive amendments have added to the subject matter of independent claims 1, 11, 19, and 26, particularly with regard to the actions of the mapping database. This has resulted in the need for a new search. The new search has resulted in new grounds of rejection. Rejection under 35 USC 102 is withdrawn as necessitated by amendment.

Pertaining to rejections under 103(a) in the previous office action

Significant substantive amendment has added to the subject matter of independent claim 26, particularly with regard to the actions of the mapping database. Because claims 32-34 depend from claim 26, this has resulted in the need for a new search. The new search has resulted in new grounds of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-2,4-12,14-20, and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit (Paper #051109; US Patent No. 4,799,156) in view of Banks (US Pub. No. 2002/0161672).

Shavit teaches an interactive electronic communication and processing system for business transactions between buyers and sellers, accessed using terminals, and

storing information in databases (see at least Abstract, Figs. 1,2,13,14; column 2 lines 9-15, column 5 lines 39-65). Shavit further teaches:

- receiving a quotation including at least a first product and its quote amount:
quotation entry device, storing the quote amount, memory connected to the data entry device (see at least column 11 line 52 – column 12 line 18, column 16 line 50 - column 17 line 2, column 33 line 28 – column 34 line 2, column 40 lines 27 - 35); receiving the order that identifies at least the first product and desired quantity, an order entry device (see at least column 13 line 51 – column 14 line 9); quotation entry device and the order entry device comprise a single device (see at least Abstract, column 5 lines 16-65, column 13 line 51 – column 14 line 9. Please note: as described in Shavit, virtually every function performed can be performed by the same device); calculating an order price associated with the first product by accessing the stored quote amount, and determining the order price based on the quote amount and the desired quantity, price calculator configured to receive order from order entry device, access memory, identify quote amount, and calculate price based on quantity and quote amount (see at least column 13 line 10 – column 14 line 9, column 25 lines 28 – 50).
- the product manufacturing facility is a semiconductor foundry: (Please note: The nature of the facility and its particular industry is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

- quote amount is stored in a quotation database: connected to the order entry device (see at least column 12 line 54 – column 13 line 34, column 25 lines 28 – 50, column 29 line 31 – column 30 line 2, column 33 line 28 – column 34 line 2, column 36 lines 22 – 53, column 39 lines 1-4, column 40 lines 5-17).
- storing predetermined information associated with the first product in a product database: (see at least column 2 lines 9-15, column 7 lines 6-22, column 25 line 51 – column 26 line 4, column 40 lines 28-35); updating a mapping database with predetermined information from the quotation database and the product database associated with the first product (see at least column 24 line 53 – column 25 line 9, column 31 line 32 – column 32 line 9, column 36 lines 22-53, column 40 lines 28-35); determining the order price based on the quote amount from the mapping database associated with the first product and the quantity identified in the product manufacturing facility order, mapping database is updated automatically when new quotation is entered into quotation database, when the product database is changed (see at least column 24 line 53 – column 25 line 9, column 31 line 32 – column 32 line 9, column 36 lines 22-53, column 40 lines 28-35. Please note: utilizing database triggers or auto-call functions is inherent in automatic database updating).
- receiving a quote amount for a second product: storing the quote amount (see at least column 11 line 52 – column 12 line 18, column 16 line 50 - column 17 line

2, column 33 line 28 – column 34 line 2, column 40 lines 27 - 35); calculating order price associated with the second product, wherein the received order identifies at least the first product and the second product and desired respective quantities, by accessing the stored quote amount associated with the second product, and determining the order price for the second product based on the stored quote amount associated with the second product and the desired quantity identified in the product manufacturing facility order, wherein the quote amount associated with the first product and the quote amount associated with the second product are in the same quotation (see at least column 12 line 54 – column 14 line 9, column 25 lines 28 – 50, column 29 line 31 – column 30 line 2, column 33 line 28 – column 34 line 2, column 36 lines 22 – 53, column 39 lines 1-4, column 40 lines 5-17).

Shavit teaches all of the above as noted under the 103(a) rejection and teaches a) updating a database record with information from quotation and product databases, b) associating information from various databases together in facilitation of a transaction, c) retrieving records relevant to a transaction, and d) calculating costs of an order based on product, quantity, and quote amount. Shavit, however, does not disclose:

- updating a mapping database record associated with the first product: with predetermined information from the other databases associated with the product

wherein the mapping database associates information from one database with information from another database.

- retrieving a mapping database record associated with the product from the mapping database; and
- calculating an order price based on the mapping database record:
- order created using graphical user interface:

Banks teaches a system supporting commercial transactions that synchronizes product data from various sources into an enterprise resource planning system and teaches a) maintaining product information in databases, b) product information including product descriptions and pricing information, c) updating product information in databases upon receipt of new information, and d) using compiled quantity, price, and product information to calculate order pricing. Banks further teaches:

- updating a mapping database record associated with the first product: with predetermined information from the other databases associated with the product wherein the mapping database associates information from one database with information from another database (see at least abstract, figs.1,3; page 1 para.0012; page 2 para.0016, 0019 – page 3 para.0020, 0022; page 5 para.0032).
- retrieving a mapping database record associated with the product from the mapping database: (see at least abstract; page 1 para.0012; page 2 para.0019 – page 3 para.0020,0022).

- calculating an order price based on the mapping database record: (see at least figs.1,3,5; page 1 para.0012; page 2 para.0018).
- order created using graphical user interface: (see at least page 2 para.0018).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Shavit to update a mapping database record associated with the first product with predetermined information from the other databases associated with the product, retrieve a mapping database record associated with the product from the mapping database, calculate an order price based on the mapping database record, and create an order using a graphical user interface, as taught by Banks, in order to improve the responsiveness of the system to purchasers and thereby increase commerce using the method.

Pertaining to computer readable medium and system Claims 19-20 and 22-31

Rejection of Claims 19-20 and 22-31 is based on the same rationale as noted above.

2. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit (Paper #051109; US Patent No. 4,799,156) and Banks (US Pub. No. 2002/0161672) as applied to claims 1-2,4-12,14-20, and 22-31 above, and further in view of Senior (Paper #051109; US Pub. No. 2002/0029171).

Shavit and Banks teach all of the above as noted under the 103(a) rejection and teach a) using remote terminals for inputting quotes and orders, b) using a single device for performing multiple functions such as inputting both quotes and orders, c) using

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multiple locations for storing databases containing product information, orders and quotations, and further teach accessing various databases, placing orders, and communicating quotations from remote locations via the internet. Shavit and Banks, however, do not disclose the single device being a personal data assistant, the quotation entry device connected to the memory via a wireless connection, or the order entry device connected to the price calculator via a wireless connection. Senior teaches the single device being a personal data assistant, the quotation entry device connected to the memory via a wireless connection, and the order entry device connected to the price calculator via a wireless connection (see at least page 4 para.0063). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shavit and Banks to include the single device being a personal data assistant, the quotation entry device being connected to the memory via a wireless connection, and the order entry device being connected to the price calculator via a wireless connection as taught by Senior, in order to improve the convenience of using of the system, make the system more accessible, and make the system easier to use, thereby attracting more users to the system and increasing commerce using the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wilmsen, US Patent No. 6,578,030 (June 10, 2003); Teaches combining multiple catalogs by determining characteristics and values related to the items therein and mapping the characteristic values and items to form a new combined catalog (mapping database).
- Woolston, US Patent No. 6,856,967 (Feb. 15, 2005); Teaches interacting linking of search engine and dynamic pricing content to organize links on a network into predetermined taxonomy, providing a mapping between search requests and the taxonomy. Mapping includes reference pointers to dynamic pricing content.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Fadok can be reached on 571.272.6755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine
Patent Examiner
March 29, 2006


Robert M. Pond
Primary Examiner